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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/628,908	07/31/2000	Jason A. Kay	Kay 41-53-18-79-12	5021

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EXAMINER

HOFFMANN, JOHN M

ART UNIT	PAPER NUMBER
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1731

2

DATE MAILED: 05/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

111-2

# Office Action Summary

Application No.

09/628,908

Applicant(s)

KAY ET AL.

Examiner

John Hoffmann

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22 and 23 is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### ***Drawings***

New formal drawings are required in this application because figures 2,3,5-7 are of such poor quality makes it impossible to tell what the features are . Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Further, claim 6 refers to “walls”. The more than one wall needs to be shown in the drawings - they presently only show one wall.

Still further, the internal mold supporting the end of the tube and shaping the inner surface must be shown (see at least claims 1 and 22 for instance)

### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: All of the means-plus-function features must be mentioned in the specification. It is noted that there are at least five “means for” features in the claims - there may be more. The burden is on Applicant to provide proper antecedent basis so that one of ordinary skill can turn to the specification to see what is meant by the terms.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims have means-plus-function limitations, therefore they enact paragraph 6<sup>th</sup> of 35 USC 112. However there is no mention of any of these means in the specification, therefore one would not be able to refer to the specification (as required by said 6<sup>th</sup> paragraph) to find out what they refer to and their equivalents. Additionally, the last 4 lines of page 8 of the specification indicate that the “tool...may be activated...by...any...suitable means”. It is unclear if this means that any structure that can be used to create an activation of the internal mold should be considered to be covered by the means-plus-function limitations. The term ‘suitable’ being deemed to be ‘anything that will perform the function’.

In the prior art rejections, Examiner gives the claims their broadest reasonable interpretation. In the event that Applicant deems these interpretations are unreasonable, then the claims are deemed indefinite because one cannot tell what the claims require.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7-9, 16, 17, 19  
Claims 1-5, 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Doty  
1

3293018.

Looking to the Doty figures (in particular 1 and 7): 13 and/or 17 is the support means. 15 is the heat source. 28 is the internal mold. The (unnumbered) hand-wheel on feature 14 is deemed to be the “means for inserting”. It is deemed that this hand-wheel is covered by the 112 6<sup>th</sup> paragraph interpretation because inserting the mold is an activation of the mold, and since page 8 (last four lines) . Feature 23 is the “means for compressing”: looking to the sentence spanning pages 11-12; it is deemed that this “means” can be a “paddle” and that Doty’s 23 is a “paddle”.

Claim 2: first it is noted that the claim refers to “an open, extended, configuration”. Examiner could not find any grammar/punctuation resource that makes any reference to having the present punctuation. Then turning to the specification to see what this means: page 4, line 2 mentions a configuration which is “open or extended”. But line 10 mentions “open, (i.e., extended) configuration”. And line 13 uses language similar to that of claim 2, except there is only one comma. Given all of these considerations it is deemed that the broadest reasonable interpretation is that “open, extended, configuration” is ‘open or extended configuration’. Claim 2 is met in that the internal mold can be “altered” (position-wise) so that it extends into tube (i.e. it is in an extended configuration.)

Claim 3, it is deemed that the “means for setting” can also be the handwheel - or else it can be bolts 30, 31 and/or 35. As to “its collapsed configuration for withdrawing

the mold from the tube...” it is noted that there is no prior mention (or requirement) of a “collapsed configuration for withdrawing...” Claim 2 clearly indicates that only one of the configurations is required. It is deemed that the proper way to interpret this limitation is “if there is a collapsed configuration for withdrawing...” then there must be a means for setting it. Any other interpretation would mean either claim 2 or claim 3 is indefinite - since would could not tell which of them requires both configurations.

Since Doty does not have a collapsed configuration, the claim is met because the claim requires a means for setting -only if there is a collapsed configuration.

Claim 4: like claim 3, since there is no requirement for any sort of setting, the claim is interpreted as: if there is setting, then..... Since Doty does not have this setting, the “then” portion of the conditional statement is moot - and the claim is met.

Claim 5: see figure 2, feature 23.

Claim 7 is met for the same reasons claim 1 with the following noted differences: Line 8 refers to “said variable configuration mold” but there is no prior mention of a “variable configuration mold”. Thus it is deemed to be interpreted as ‘if the mold is a variable configuration mold, then...’ Since Doty has only the extended configuration, it is not a variable configuration mold, and therefore the conditional limitation is met because the initial conditional test is not met.

The second difference between claim 1 and 7: Claim 7 has only one comma : “open, extended configuration” (“closed, collapsed, configuration” still has two commas). As can be seen in figure 2, the phantom -line version of feature 23 shows that the mold can be open - it has to be open so that the tube can be inserted as shown in figure 5. The being extended is discussed above.

AS to the causing the inner surface to conform, such is a method of use. Although it may not occur in the tube that Doty shows, by using a tube with a pre-shaped end, the conforming could be effected.

Claims 8-9 are met as per above.

Claim 16 is essentially nothing but method of use limitations. There is no structural limitation that defines over Doty.

Claim 17 is clearly met.

Claim 19 is clearly met.

### ***Claim Rejections - 35 USC § 102***

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Zauner 3257186.

See features 22, 23, 28 and 27 of figure 1 and the associated text of Zauner. Further, see how the claims are to be interpreted (above.)

Claims 7-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Zauner 4441908.

See figure 10. 308 are the inner mold and 276 points to one of the outer mold. The paragraph spanning cols. 8-9 discloses the operation of the device in the same manner as Applicant claims their invention.

As to claim 11 the Zauner shape is “oblate, cone-like” in as much as applicant’s glass tube is.

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18, 20 and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doty 3293018.

It would have been obvious to completely automate the Doty process/apparatus so that it makes the tubes automatically - because it would be cheaper than having a person do it. It would have been further obvious to use optical imaging to check the final product to make sure that the final product is not defective.

Claim 20 : figure 2 shows the heat being applied to the selected end of the tube. Col 5, lines 58-62 indicates that the glass is being heated prior to the molding. It would have been obvious to have the glass being heated during all the time from prior to the insertion of the mold - until at least the time shown in figure 2, because if the heating stopped, it would let the glass cool down and extend the required processing time, and because it would preclude the need to re-ignite the flame. The mold would then need to be opened during at least part of the heating. Although the claim refers to “the time” there is no antecedent basis for “the time”, this is interpreted as being “a” time. It would



have been further obvious to repeat the process many times, so as to make many tubes. Thus when making a given tube, there was a time prior to the heating (of that tube) when the mold was in an "open configuration." I.e. when any of the previously made preforms were being made.

Claim 21 is clearly met.

### *Allowable Subject Matter*

Claims 12-15 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claims 22-23 are allowed.

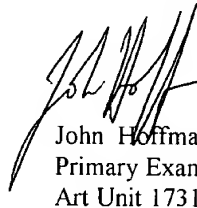
### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Guenther, Brown, Meyer Sundstrom, Curtis, Smith, Adams, Zaunrt '495, Hofmann, and Licentia are cited as being of general interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is 703-308-0469. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 703-308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7115 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

 5-24-02  
John Hoffmann  
Primary Examiner  
Art Unit 1731

jmh  
May 24, 2002